

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

WILLIAM EAMON CARROLL et al.

Serial No. : 10/799,793

Filed: MARCH 12, 2004

Art Unit: 1731

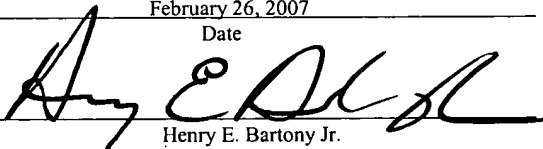
Examiner: Michael J. Felton

Atty Dock No.: 02-017 CIP

COMPOSITION FOR INCREASING  
CELLULOSIC PRODUCT STRENGTH AND  
METHOD OF INCREASING CELLULOSIC  
PRODUCT STRENGTH

Pittsburgh, Pennsylvania 15230  
February 26, 2007

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING	
I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.	
On	February 26, 2007
	Date
	
Henry E. Bartony Jr. Registration No. 34,772	
	February 26, 2007
	Date
Total Pages: 4	

Sir:

**RESPONSE TO RESTRICTION REQUIREMENT**

In the Office Action dated October 25, 2006, the Examiner required restriction to one of the following inventions 35 U.S.C. Section 121:

- I. Claims 1-17, drawn to a hydrogel (a hydrophilic polymer) containing a saccharide, classified in class 525, subclass 221.
- II. Claim 18-39, drawn to the application of I to the production of paper, classified in class 162, subclass 164.

Specifically, the Examiner asserted that:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h).

In the instant case, invention I (the product) can be used for materially different processes. For instance, hydrogels can be used to control the flow of liquids (see US 4,450,198 to Michaels) and to contain substances for later delivery (see US 6211296 B1 to Frate, et al.).

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species: (partially hydrolyzed poly(N-vinylformamide), partially hydrolyzed vinyl acetate/ N-vinylformamide copolymer, hydrolyzed acrylonitrile/ N-vinylformamide copolymer, amine functional polyacrylamide, acrylic acid/vinylamine copolymer, maleic anhydride/maleic acid copolymers with N-vinylformamide/vinylamine, N-vinylformamide/vinylamine polymers with vinyl sulfonate comonomer units, NVF/vinylamine copolymers with at least one cationic monomer, allylamine polymer, diallylamine polymer, allylamine/diallylamine copolymer, urea/formaldehyde condensation polymers, melamine/formaldehyde condensation polymers, amidoamine polymers, amine/epichlorohydrin polymers, poly(ethyleneimine), hydrolyzed poly(2-alkyl-2-oxazoline), partially hydrolyzed poly(2-alkyl-2-oxazoline), a copolymer of vinyl amine and vinyl alcohol, or a NVF/vinylamine copolymer with diallyldimethylammonium chloride or with a cationic acrylate comonomer. The species are independent or distinct because the polymers listed have different characteristics resulting in materially different products.

This application also contains claims directed to the following patentable distinct species: monosaccharides, disaccharides, polysaccharides, and saccharides containing glucose, lactose or 2-deoxy-D-ribose. The species are independent or distinct because the invention would contain different saccharides, which could affect its end use.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

The applicant should select one composition. An example would be NVF/vinylamine copolymer with diallyldimethylammonium chloride and a disaccharide containing lactose.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicants hereby elect Claims 18-39 of Group II set forth by the Examiner without traverse.

It is not apparent, however, if the Examiner's requirement of an election of species in the office action extended to the method claims of group II. If the requirement of election of species extends to claims 18-39 of Group II, Applicants hereby elect, with traverse, the species wherein the polymer is a copolymer of vinyl amine and vinyl alcohol

and the saccharide is a monosaccharide containing glucose. Applicants respectfully assert that claims 18-28 and 32 and 34 read on the elected species and are generic.

If the requirement of election of species extends to claims 18-39 of Group II, Applicants respectfully assert that examination of all of the species asserted by the Examiner will require search of essentially the same art and will not place an undue burden upon the Examiner. In the interest of expedient and efficient prosecution, Applicants respectfully request that the requirement of an election of species (if the requirement of election of species extends to claims 18-39 of Group II) be withdrawn.

Applicants respectfully requests that the Examiner indicate the allowability of Claims 18-39 and arrange for an official Notice of Allowance to be issued in due course.

Respectfully submitted,  
WILLIAM EAMON CARROLL et al.

Date: February 26, 2007

By   
Henry E. Bartony, Jr., Esq.  
Reg. No. 34,772

Bartony & Hare, LLP  
Suite 1801, Law & Finance Building  
429 Fourth Avenue  
Pittsburgh, Pennsylvania 15219  
412-338-8632 (telephone)  
412-338-6611 (fax)

Attorney for Applicant